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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,312	11/26/2001	Koji Taniguchi	MAT-8204US	8396

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EXAMINER
MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,312	TANIGUCHI ET AL.	
	Examiner	Art Unit	
	Steven B. McAllister	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *10-15,19-24,28-31,39 and 40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,16-18,25-27 and 32-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/26/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-9, 16-18, 20, 21, 25-27 and 31-38 in the reply filed on 10/12/2004 is acknowledged.

Claims 10-15, 19, 22-24, 28 and 31-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/12/2004.

Regarding claims 20, 21 and 31, it is noted that due to a typographical error by the examiner, these claims were inadvertently included with the claims of Group I. However, these claims are directed toward the invention of Group II. Therefore claims 20 and 21 and withdrawn from further consideration.

It is noted that claims 20 and 21, were they to be examined would be anticipated by Florance et al.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32 and 33 have several instances of lack of antecedent basis (e.g., the first instances of "the content", "the distributor" in claim 32.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-9, 16-18, 25-27, and 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Florance et al (2003/0078897).

Florance shows storing a request for delivery of content, the request provided by a user and having a delivery validity period comprising the subscription period, the address of the user, a content attribute comprising e.g., a type or category of property, and a content identifying information comprised of an arbitrary character string; extracting the delivery request within the validity period; selecting content conforming to the attribute from a content management database; generating transmit data, including the content identifying information and content; and delivering the transmit data.

As to claims 16-18 and 25-27, it is noted that Florance shows software and hardware performing all recited steps.

As to claims 32 and 33, Florance shows all steps.

As to claim 34, Florance shows a delivery registration unit capable of storing a request for delivery; a content delivery unit.

As to claim 35-37, Florance shows a program delivery unit capable of delivering to an arbitrary terminal a program performing all recited steps.

As to claim 38, Florance shows all elements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Florance et al in view of Sealand et al (2003/0014402).

As to claim 5, Florance shows including the content data of an email generated by the system. Florance does not explicitly show placing the content identifying information in the header. Sealand shows this step. It would have been obvious to one of ordinary skill in the art to modify the method of Florance by providing the content identifying information in the header in order to provide quick identification of the contents of the message.

Claim 6 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Florance et al.

Florance shows all steps except providing advertising content to the content according to the information about the billing form. However, it is notoriously old and well known in the art to do so. For instance, it is notoriously old and well known to provide web service or email at a reduced or free price relative to the fee normally charged in return for placing advertisements in the content. It would have been obvious to one of ordinary skill in the art to modify the method Florance by providing such an option in order to enhance revenue via advertisements and maximize the number of users.

Alternatively, as to claim 38, Florance shows all steps except a content registration unit capable of accepting content and a request to deliver from an arbitrary server. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Florance by providing such a content registration unit in order to accept information regarding properties from a plurality of sources.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER